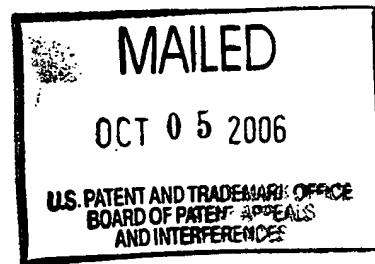


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JOHN FALK KELLEY,  
JASON THOMAS YUEN, MICHAEL P. HECK  
and  
MATTHEW D. GARAY

Application 10/001,744

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 25, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that in the Final Rejection mailed March 24, 2005, the following § 103 rejections were made:

Claims 1-4, 6, 7-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky et al. (or hereinafter “Katinsky”) (USP 6452609) in view of Madnick et al (or hereinafter “Madnick”) (US 5913214)[page 2];

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Madnick and Wecker and further in view of Nikolovska (USP 6452609)[page 6];

Claims 1-4, 6, 7-10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky et al (or hereinafter “Katinsky”) (USP 6452609) in view of Madnick et al (or hereinafter “Madnick”) (US 5913214) and Wecker (US 5806077)[page 7]; and

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky in view of Madnick and Wecker and further in view of Nikolovska (USP 6452609)[page 11].

It should be noted that the two rejections for claims 5 and 11 are identical. However, clarification is required regarding the status of the two rejections listed for claims 1-4, 6, 7-10, 12 (only one includes Wecker).

In addition, in the Examiner’s Answer mailed June 7, 2006, the examiner lists the following rejections:

Claims 1-4, 6, 7-10 and 12 are rejected under 35 U.S.C. 103(a)  
As being unpatentable over Katinksy [sic, Katinsky] or

hereinafter “Katinksy” [sic] (USP 6452609) in view of Madnick et al (or hereinafter “Madnick”) (US 5913214) [page 8]; and

Claims 5 and 11 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katinksy [sic] et al (or hereinafter “Katinksy” [sic] in view of Madnick et al (or hereinafter “Madnick”)(US 5913214) and further in view of Nikolovska (US 6452609)[page 8].

It appears that the § 103(a) rejection of claims 5 and 11 12 is a new ground of rejection because of the addition of claim 12 and the fact that Wecker is not included in the rejection.

37 CFR § 41.39 (2005) states:

§ 41.39 Examiner’s answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner’s answer may include a new ground of rejection.

(b) If an examiner’s answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner’s answer exercise one of the following two options to avoid sua sponte dismissal of the

appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters

in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed June 7, 2006. Once the Examiner's Answer mailed June 7, 2006 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Finally, § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

The "Evidence Relied Upon" section appearing on page 8 of the Examiner's Answer mailed June 7, 2006, is deficient because it does not contain a listing of the evidence relied upon. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) to determine the status of the grounds of rejection appearing in the Final Rejection mailed March 24, 2005;
- 2) to vacate the Examiner's Answer mailed June 7, 2006;
- 3) to select one of the following options:
  - a) reopen prosecution;

- b) write a new Examiner's Answer without the new grounds of rejection; or
- c) write a new Examiner's Answer properly setting forth the new ground of rejection;

4) to correct the " Evidence Relied Upon " section appearing in the Examiner's Answer; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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